

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIMITRI KANEVSKY, STEPHANE HERMAN MAES, and
ALEXANDER ZLATSIN

Appeal 2007-0555
Application 09/558,372
Technology Center 2600

Decided: May 22, 2007

Before JOSEPH L. DIXON, MAHSHID D. SAADAT, and JAY P. LUCAS,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §§ 6(b) and 134 from the Examiner's final rejection of claims 1-24.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a method and apparatus for transmitting data in a packet network using a portion(s) of a larger biometric sample. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for transmitting biometric data in a network, comprising the steps of:

obtaining biometric information for a user;

obtaining a plurality of biometric portions from said biometric information, wherein one or more of said plurality of biometric portions identifies or verifies said user; and

transmitting said biometric portions to a destination using a plurality of packets.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Barrett	U.S. 5,917,835	Jun. 29, 1999
Pare, Jr.	U.S. 6,154,879	Nov. 28, 2000
DeSchrijver	U.S. 6,311,042 B1	Oct. 30, 2001

REJECTIONS

Claims 1-3 stand rejected under 35 U.S.C. 102(e) as being anticipated by DeSchrijver.

Claims 1 and 4-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. in view of Barrett.

We are unsure of why the Examiner has not included claims 2 and 3 in the rejection under 35 U.S.C. § 103(a), nor why the Examiner did not reject independent claim 15 under 35 U.S.C. § 102, which corresponds to independent claim 1. With this said, we will address the rejections as set forth by the Examiner and as grouped by Appellants in their respective headings in the Brief.

Additionally, we note that Appellants' Brief is not in compliance with 37 C.F.R. § 41.37. The Brief does not contain a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters." (37 C.F.R. § 41.37 (c)(1)(v)). Additionally, we note that the language of independent claims 20-24 contains what appears to "means plus function" or "step plus function" limitations, but the Summary of the Claimed Invention does not address these claim limitations to provide the corresponding structure, acts, or materials in Appellants' Specification. Rather than remand the appeal at this stage, we have elected to decide the appeal on the merits.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Jul. 27, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed May 9, 2006) and Reply Brief (filed Sep. 25, 2006) for the arguments there against.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to “‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the

art at the relevant time. *See Studiengesellschaft Kohle, M.B.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27, 220 USPQ 841, 842-43 (Fed. Cir. 1984).

From our review of the Examiner's rejection of independent claim 1, we find that the Examiner has at least established a prima facie case of anticipation of independent claim 1 and shown that DeSchrijver teaches all of the limitations recited in independent claim 1. Therefore, we look to Appellants' Briefs to show error in the Examiner's prima facie case.

Appellants argue all three references under the same grouping and intermingle the discussion of the references. Appellants' main contention is that DeSchrijver does not teach obtaining portions of biometric data for identifying or verifying a user. Appellants further contend that DeSchrijver does not disclose that the signature contains a plurality of biometric portions. Additionally, Appellants contend that data packets that contain parts of a signature are not biometric portions in the context of the present invention (Br. 4-5).

We find that Appellants have not identified any specific citation in the Specification, nor have Appellants provided any extrinsic evidence defining "biometric portions" which would show error in the Examiner's claim interpretation. Therefore, since the Examiner used the common meaning of the term, we cannot agree with Appellants that the Examiner has interpreted the claim language in an unreasonable manner.

Appellants argue that DeSchrijver does not address biometric portions for identifying or verifying a user and does not address plural biometric portions (Br. 5). We find the Examiner's reliance upon the dynamics of the pen motion and the form of the image on the surface (Answer 3) to be

individual portions of the persons' biometric data which are transmitted to a destination. Here, we find no express language that requires that portions of be a subset of a larger biometric data.

Appellants argue that DeSchrijver does not teach biometric portions in the context of the present invention (Br. 5). As discussed above, we find that Appellants have neither established any specialized definition in this prosecution history, in the present Specification, nor in the cited application 09/467,581 (Reply Br. 2). Therefore, Appellants' argument is not persuasive. Appellants argue that the biometric portions are for example, portions of biometric information which contain enough information to identify (or verify the identity of) a user, but which do not contain the entire biometric information. Appellants further argue that data packets that contain parts of a signature are not biometric portions in the context of the present invention and as required for proper operation of the invention (Reply Br. 3). We find no support for Appellants argument in the express language of independent claim 1. Therefore, Appellants' argument is not persuasive, and we find that DeSchrijver teaches all of the limitations of independent claim 1. Therefore, we will sustain the rejection of independent claim 1 and dependent claims 2 and 3 grouped therewith by Appellants.

35 U.S.C. § 103

At the outset, we note that to reach a proper conclusion under § 103, the Examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the Examiner to ascertain

whether the Examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: “[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact.” *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the

challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited and disputed in independent claim 1. From our review of the Examiner’s rejection, we find that the Examiner has set forth a proper initial showing, with respect to independent claim 1, to shift the burden to Appellants. We note that the Examiner has relied upon the teachings of Barrett with respect to the interleaving of the biometric or generic data. We agree with the Examiner that the division of a set group of data and interleaved transmission would have been a desirable methodology to address data loss (Answer 4-5). Additionally, we find that Pare teaches all of the limitations of independent claim 1.

We find that Pare teaches obtaining biometric information for a user (Pare at col. 5, ll. 22-25)). Pare teaches obtaining a plurality of biometric portions from said biometric information, wherein one or more of said plurality of biometric portions identifies or verifies said user; (Pare col. 7, l. 64 - col. 8, l. 20 and col. 11, l. 63 - col. 12, l. 8 (primary and secondary biometric samples)). Pare teaches transmitting said biometric portions to a destination using a plurality of packets (Pare col. 5, ll. 28-34). With the teachings of Barrett to additionally teach the interleaving of data, we find that the combined teachings fairly suggest the invention as recited in independent claim 1.

We look to Appellants responsive arguments to show error in the initial showing. Appellants argue that neither Pare nor Barrett disclose or suggest “creating biometric portions from biometric information” (Br. 6 and Reply Br. 3-4). We find no support in the language of independent claim 1 for the step of “creating.” Therefore, appellants' argument is not persuasive. Additionally, as discussed above, we find no express or implied definition of “biometric portions.” Therefore, Appellants’ reliance thereon does not support Appellants argument. Since Appellants have not shown error in the Examiner’s initial showing, we will sustain the rejection of independent claim 1 and claims 4-24 which Appellants have grouped therewith.

CONCLUSION

To summarize, we have sustained the rejection of claims 1-3 under 35 U.S.C. § 102, and we have sustained the rejection of claims 1 and 4-24 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

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AFFIRMED

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